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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050318
Party	Defendant Solid 21 Incorporated
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Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	GEORGE E. AKWO, ESQ.
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Date	03/16/2009
Attachments	motion to dismiss petition.pdf ( 5 pages )(152566 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MAKUR DESIGNS, INC.,	)	Cancellation No. 92050318
	)	Registration No. 2,793,987
Petitioner	)	
	)	<b>RESPONDENT’S MOTION TO</b>
-against-	)	<b>DISMISS PETITION WITH</b>
	)	<b>PREJUDICE FOR FAILURE TO</b>
SOLID 21 INCORPORATED,	)	<b>STATE A CLAIM FOR WHICH</b>
	)	<b>RELIEF CAN BE GRANTED</b>
Respondent.	)	(Trademark Rule 2.116(a); 37 CFR
_____	)	37 CFR § 2.116(a)); FRCP Rule 12b(6)

**NOTICE OF MOTION TO DISMISS**

**TO: PETITIONER AND THE BOARD:** Respondent Solid 21 Incorporated

(“Respondent”) respectfully moves the Board for an order dismissing this Cancellation proceeding Petition with prejudice for failure to State a claim for which relief may be granted. In support of its Motion, Respondent states as follows:

**STATEMENT OF THE GROUND FOR THIS MOTION**

Petitioner Makur Designs Inc. (“Petitioner”) seeks cancellation of Respondent’s RED GOLD trademark described as “a special alloying of gold with a distinct color made into fine jewelry.....” *Petition para. 2*. According to the Petition, the “gold with a distinct color is “reddish” *Petition para. 2*, or maybe outright “red”. *Petition, para. 5*. However, the Petition then illuminates its fatal flaw requiring dismissal, to wit, that the same RED GOLD that Petitioner claims describes the “red-colored gold that Respondent has for sale”, *Petition para. 5*, also SUGGESTS other colors:

- a. “red” that petitioner uses to identify the color of its own jewelry, *Petition para. 1*;
- b. “red-colored gold that Respondent is offering for sale.” *Petition para. 5*.
- c. Reddish gold (*Petition, para. 2*
- d. red-colored gold (*Petition, para. 6*)
- e. rose gold (*Petition para. 6*)
- f. pink gold (*Petition para 6*).

### **BRIEF IN SUPPORT OF MOTION**

#### **THE PETITION ITSELF CONCEDES THAT THE MARK IS SUGGESTIVE RATHER THAN DESCRIPTIVE**

It is well settled that, where, as here, cancellation is sought because the mark is allegedly descriptive, the test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant’s favor. *In re Atavio*, 25 USPQ2d 1361 (TA+TAB 1992).

The mark RED GOLD at issue here is “a special alloying of gold with a distinct color made into fine jewelry...” *Petition para. 2*. Petitioner contends that RED GOLD describes gold in the distinct color of red, reddish, pink, or rose. Even accepting as true, for the purposes of this motion only, gold in its natural state is yellow and never red, pink, rose, reddish, green or any


other hue other than yellow. .See [www.thefreedictionary.com/gold](http://www.thefreedictionary.com/gold).<sup>1</sup> To get gold into another hue, the process of alchemy is required. For the Petition to survive therefore, it will require the Board to conclude that a person who picks up gold in hues of red, pink, rose, reddish, will automatically conclude that it is RED GOLD and nothing else, without additional reasoning, deduction or information. In other words, the Petition concedes that RED GOLD does not describe color but is suggestive of color.

### **CONCLUSION**

Accordingly, Respondent respectfully requests that the Petition be dismissed with prejudice in that it fails to state a claim for which relief can be granted.

Dated: March 15, 2009,

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'GEORGE E. AKWO', with a long horizontal flourish extending to the right.

By: \_\_\_\_\_  
GEORGE E. AKWO, ESQ.  
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Attorneys for Respondent  
Solid 21, Incorporated

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<sup>1</sup> Defining *Gold* as (Symbol Au): A soft, yellow, corrosion-resistant element, the most malleable and ductile metal, occurring in veins and alluvial deposits and recovered by mining or by panning or sluicing).

**AFFIDAVIT OF SERVICE: STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

My business address is 2118 Wilshire Boulevard, #1010, Santa Monica, CA 90403.

I am over the age of 18 years and not a party to this action. I am readily familiar with the business practice for collection and processing of correspondence under all of the methods described therein.

On March 16, 2009. I caused the following documents: **Motion To Dismiss Petition**, to be served on:

Phillip Furgang, Esq.  
2 Crossfield Avenue  
West Nyack, NY 10994

The manner of service was as follows:

( x ) (BY REGULAR MAIL): I am "readily familiar" with the firm's practice for collection and processing of correspondence for mailing. Under that practice it would be deposited with the United States Postal Service on that same day with postage thereon fully prepaid at Santa Monica, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after deposit for mailing affidavit.

( ) (BY OVERNIGHT DELIVERY SERVICE): I served the foregoing document by U.S. Postal Service Express Mail (overnight) or Federal Express, an express service courier which provides overnight delivery. I placed true copies of the foregoing document in sealed envelopes or packages designated by the express service carrier, addressed to each interested party as set forth above, and with fees for overnight delivery paid or provided.

( ) (BY PERSONAL SERVICE): I caused such envelope to be delivered by hand to the offices of the above named addressee(s).

( ) (BY FACSIMILE): The documents(s) were transmitted by facsimile transmission to the office of the addressee(s) at the following facsimile number: \_\_\_\_\_. The transmission(s) reported as complete and without error. The facsimile machine I used complied with the California Rules of Court, Rule 2.306(g) and I printed a record of the transmission(s), a copy of which is attached to the original of this declaration.

I declare under penalty of perjury that the foregoing is true and correct under the laws of the State of California, and the United States that this affidavit was executed on March 16, 2009 at Santa Monica, California.

///

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Dated: March 16, 2009,

A handwritten signature in black ink, appearing to be 'GEA' with a long horizontal stroke extending to the right.

By: \_\_\_\_\_  
GEORGE E. AKWO, ESQ.